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EXAMINER

LAYNO, CARL HERNANDZ

ART UNIT PAPER NUMBER

3762

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/099,929

Applicant(s)

ROGERS ET AL.

Examiner

Carl H. Layno

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-24, 36-42 and 44-48 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9, 10, 12-20, 25-34, 43 and 49 is/are rejected.
- 7) ☒ Claim(s) 6, 8, 11 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/5/04, 7/28/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. Acknowledgment is made of applicant's Information Disclosure Statements (PTO-1449) which were received by the Office on April 5, 2004, July 28, 2003, June 4, 2003, and April 23, 2003.

Drawings

2. Applicant's drawings are informal and are acceptable for examination purposes only. See attached PTO-948 for Draftsperson's comments.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Specifically, in line 13 of the Abstract, the applicant recites "a means for determining". To overcome this objection to the specification, the Examiner recommends replacing the words "a means" with the word "circuitry".

Claim Rejections - 35 USC § 112

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12-20, 43, and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 12, the claim is indefinite in that the statement "at least on implanted device" (line 13) makes no sense. To correct this typographical error, the Examiner recommends changing the word "on" to the word "one". Claims 13-20 are rejected since they depend from rejected claim 12.

In regard to claim 43, the claim is indefinite in that the statement "the implanted device in not operating properly" (line 13) makes no sense. To overcome this rejection, the Examiner recommends changing the word "in" to the word "is".

In regard to claim 49, the claim is indefinite in that it is unclear if the applicant is trying to claim an apparatus or a method. Line 1 of the claim refers to "A system for monitoring..." while line 2 of the claim refers to "the method comprising". The applicant then goes on to list *structural* "means" of the device not method steps. To overcome this ambiguity, the Examiner recommends replacing the word "method" (line 2) with the word "system".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Adams et al '245 or Markowitz et al '630 (both cited by the Applicant as prior art).

The Adams et al '245 patent, cited by the applicant as prior art, describes a storage interrogation device **13** (Figs. 1-3, 5, and 6) which reads upon applicant's claimed "communications device". The device **13** communicates wirelessly with an implanted defibrillator **11,17** (Figs. 1-2) and with an external monitor/computer system (Fig. 4). The interrogation device **13** (Fig. 6) includes memory **43** and a microprocessor **42** for performing the functions of applicant's "control module". In regard to claim 2, applicant's attention is directed to power supply **41** (Fig. 6).

The Markowitz et al '630 patent, cited by the Applicant, recites a system for telemetry including a repeater **14** (Fig. 2), which performs the function of applicant's "communications device" by providing communications between an implanted medical device **12** and an external monitoring station **10**. The communications device comprises a processor/buffer **22**, which performs the functions of applicant's claimed control module and memory device (see also **70** of Fig. 7). Though not shown, the repeater **14** (Fig. 7) would inherently have some kind of power supply for powering its processor/buffer **22,70**, indicator circuits **76,78,80**, and repeater circuits **58,60,62**.

In regard to claim 4, all communications between the implanted devices of Adams et al and Markowitz et al and their communications devices are bi-directional.

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8. Claims 1, 2, 4, 7, 12, 15-17, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Duffin et al '976 (Applicant's prior art).

The Duffin et al '976 patent, also cited by the Applicant, discloses a communications device **20** (Fig. 1) capable of communicating with multiple implanted devices **12,14** inside a patient **10** and with externally located monitoring equipment and satellite/cellular telephone networks, **50,82,80**. The device **20** is an Intel 486XX microprocessor with associated RAM and ROM memories (col.9, lines 60-63).

In regard to claims 2 and 7, the device contains a rechargeable power supply **74**.

In regard to claim 12, applicant's attention is directed to Fig.2, which shows a monitoring center **50** connected to a long range satellite communications network **62,80**, and to an external monitor site **82** located in close proximity to a patient **10** having a belt mounted "transceiver apparatus" **30**, which in turn, communicates with the patient's own implanted medical device **12** (col.12, lines 27-41).

In regard to claim 15, applicant's attention is directed to land-lines **32** of Fig.2.

In regard to claim 16, applicant's attention is directed to satellites **62** and **80** of Fig.2.

9. Claims 1-5, 7, 9, 10, 25, 29, and 31-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al '588.

The Cox et al '588 patent describes a cardiac stimulation system (Fig.1) having all of applicant's claimed features including a communications device **100** for communicating with a plurality of implanted medical devices **200** and for communicating with an external monitoring programmer **300**. The communications device or "planet" **100** includes a CPU 142 for

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performing the function of applicant's "control module" and both non-volatile memory **110** and volatile memory **114** for storing data.

In regard to claim 2, a battery **118** is provided as the power supply for device **100**.

In regard to claims 3 and 5, the device **100** (Fig.2) would inherently be encased in a sealed biocompatible casing (not numbered) since it is designed to be implanted within the patient's body.

In regard to claim 4, communications between device **100** and implantable "satellite" devices **200** are two-way since both devices comprise transceivers. See Figs.2 and 5.

In regard to claims 7 and 9, battery **118** can be a rechargeable battery (col.7, line 60 thru col.8, line 6), which can be recharged inductively.

In regard to claim 31, applicant's attention is directed to col.15, lines 43-50. The planet/"transceiver" **100** stores satellite device status information in its memory prior to transmission to the external processing/monitoring unit **300**.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al '588 in view of Snell '771 (Applicant's prior art).

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Though the Cox et al recites many of applicant's claimed features including the use of an external programmer/monitor **300** for communicating with implanted planet device **100**, it fails to specify further details of this unit.

The Snell '771 patent, cited as prior art by the Applicant, also describes an external monitor **10** in wireless communications with implanted medical device **16** (Fig.1).

Lacking any criticality, to have specified an external programmer of the kind used by Snell '771 for that of Cox et al '588 would have been an obvious, if not arbitrary, selection to one of ordinary skill in the art of external device monitor/programmers.

In regard to claims 27-30, the external monitor/programmer **10** of Snell '771 includes typical features such as user input devices **18**, a display **20**, speaker **25**, and a telemetry head **14** for permitting two way user interaction with the monitor and communication capability with any implanted device.

Allowable Subject Matter

12. Claims 43 and 49 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

13. Claims 13, 14, and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

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14. Claims 6, 8, 11 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claims 21-24, 36-42, and 44-48 are allowed.

16. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl H. Layno whose telephone number is (703) 308-3694. The examiner can normally be reached on Monday thru Thursday from 9 AM to 6 PM and every other Friday between 9AM and 5PM. A voice mail or E-mail message (carl.layno@uspto.gov) may be left if desired.

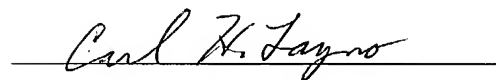
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes, can be reached on (703) 308-5181. The current fax number for this Group is (703) 305-3590. Alternatively, for official correspondence, one may use the RightFax number (703) 872-9302 and for unofficial faxes (703) 746-4873. For after final actions, use (703) 872-9303.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Legal Instruments Examiner (LIE) Brenda Webb whose telephone number is (703) 305-7520.

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A handwritten signature in cursive script, reading "Carl H. Layno", is written over a horizontal line.

CARL LAYNO
PRIMARY EXAMINER

CHL

5/17/2004